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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,145	04/13/2004	Masahiro Kisono	2271/72197	6384
23432 7590 05/01/2008 COOPER & DUNHAM, LLP 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036				
EXAMINER ANWARI, MACEEH				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/824,145

Applicant(s)

KISONO, MASAHIRO

Examiner

MACEEH ANWARI

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-16 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 01/07/2008
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the amendments filed on 1/11/2008. Claims 1-16, as originally filled, are currently pending and have been considered below.

Drawings

2. The drawings are objected to because the word *root* is misspelled as *route* in figures 5 and 14. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant states that the setting information is acquired from a setting information management server; however in claim 1 applicant mentions that setting information is acquired from one of the other network terminal apparatuses.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-12 & 14- 16 are rejected under 35 U.S.C. 101 because the claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "non-functional descriptive material." Both types of "descriptive material" are non-statutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the

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descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming non-functional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claims 1- 16** rejected under 35 U.S.C. 103(a) as being unpatentable over

Kayashima et al. (hereinafter **Kayashima**) U.S. Publication No.: 2003/0055939 A1, and further in view of **Henderson** U.S. Publication No.: 2006/0101071 A1.

Regarding **claim 1, Kayashima** teaches: a network terminal apparatus connected to other network terminal apparatuses via a network, the network terminal apparatus comprising: a storing unit that stores setting information of the network terminal apparatus; an acquiring unit that transmits an acquisition request for acquiring setting information to one of the other network terminal apparatuses, receives the setting information from the one of the other network terminal apparatuses (Figures 2 & 5-8 and Abstract & Par. 53; transmission source, transmission destination and request from network manager); a setting unit that sets the received setting information to the network terminal apparatus and stores the received setting information in the storing unit (Figures 2 & 5-8 and Abstract & Par. 53-54; transmission source, transmission destination and setting information to target product) a transmitting unit that, in response to receipt of an acquisition request for the setting information stored in the storing unit from another one of the other network terminal apparatuses, retrieves the setting information from the storing unit, and transmits the retrieved setting information to the other one of the other network terminal apparatuses (Figures 2 & 5-8 and Abstract & Par. 53-54; transmission source, transmission destination and setting information to target product).

Kayashima does not explicitly disclose wherein the target device is transmitting setting information to another target device.

The general concept of a client being able to do the same thing as a server is well known in the art as shown by **Henderson** (par. 97).

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the teachings **Kayashima** with that of **Henderson** to allow for a more efficient network environment.

Claim 2: Wherein the acquiring unit transmits an acquisition request for acquiring a designated item of the setting information, and receives the designated item of the setting information (Figures 2 & 5-8 and Abstract & Par. 53-54; transmission source, transmission destination and request from a network manager).

Claim 3: Wherein the network terminal apparatus acquires the setting information from a setting information management server provided in the network, that manages the setting information of the network terminal apparatuses (Figures 2 & 5-8 and Abstract & Par. 53-54; transmission source, transmission destination and request from a network manager).

Claim 4: Wherein the network terminal apparatus acquires the setting information from the setting information management server at predetermined intervals (Figures 2 & 5-8 and Abstract & Par. 53-54; transmission source, transmission destination and integrated management server).

Claim 5: The network terminal apparatus, further comprising: a transforming unit that, if format of the received setting information does not match format of the network terminal apparatus, transforms the received setting information into format-adjusted setting information (Figures 2 & 5-8 and Abstract; edit program, receive setting information file and communication program); wherein the setting unit sets the format-adjusted setting information to the network terminal

apparatus and stores the format-adjusted setting information in the storing unit (Figures 2 & 5-8 and Abstract; edit program, installing and setting information file and communication program).

Claim 6: Wherein the transforming unit transforms the received setting information based on style sheet that defines an attribute of each element of the setting information (Figures 2 & 5-8 and Abstract & Par. 53-54 & 68 & 70; transmission source, transmission destination and request from a network manager and XSL).

Claim 15: wherein said setting information received by said network terminal apparatus from said one of the other network terminal apparatuses corresponds to the setting of said one of the other network terminal apparatuses (Figures 2 & 5-8 and Abstract & Par. 53; transmission source, transmission destination and request from network manager).

Claim 16: wherein said another one of the other network terminal apparatuses is set based on the setting information received by said another one of the other network terminal apparatuses from said network terminal apparatus (Figures 2 & 5-8 and Abstract & Par. 53; transmission source, transmission destination and request from network manager).

Regarding **claims 7- 14** they are substantially the same as **claims 1-6 & 15- 16** and are thus rejected for reasons similar to those in rejecting **claims 1-6 & 15- 16**.

Examiner Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Response to Arguments

9. Applicant's arguments with respect to **claims 1- 16** have been considered but are moot in view of the new ground(s) of rejection.
10. Furthermore with regards to applicant's arguments for **claims 1-12 & 14-16**, the functions of a storing unit, an acquiring unit, a setting unit and a transmitting unit can all be performed through software; therefore the claims still lack the necessary physical articles to fall within a statutory category. Rejections to these claims are still maintained and for further clarification refer to rejection above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MACEEH ANWARI whose telephone number is (571)272-7591. The examiner can normally be reached on Monday-Friday 7:30-5:00 PM ES.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M.A.

/William C. Vaughn, Jr./
Supervisory Patent Examiner, Art Unit 2144